

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Singh, et al.	
Application No.: 10/604,166	
Filed: 6/28/2003	Group Art Unit: 1714
Title: Transparent Flame Retardant Polycarbonate Compositions	Examiner: Tae H. Yoon
Attorney Docket No.: GEPL.P-072	Confirmation No. 1165

REPLY BRIEF FOR APPELLANT

This Rely Brief is filed in support of Applicants' Appeal from the rejection mailed June 7, 2006, and in response to the Examiner's Answer mailed May 3, 2007. Once again, consideration of the application and reversal of the rejections are respectfully urged.

Section 112, Enablement Rejection

In the response to argument section of the Examiner's Answer, (Page 8) the Examiner continues the errors noted in the Appeal brief, and makes several new, but still erroneous arguments.

The Examiner offers no reasons for why the teaching of the specification of what does not work can be used as a basis for asserting a lack of enablement. The negative examples are excluded from the scope of the claims. This is significant because, as observed in *In re Mark*, 12 USPQ 2d 1904 (POBAI 1989) routine experimentation is permissible and does not provide a basis for a lack of enablement. That a given concentration within the clearly defined and recited range may be unsuitable for a particular quencher does not create a *per se* basis for an enablement rejection because the testing to determine the optimum concentration is routine once

the fact that there is an optimum is known from the disclosure of the invention. The Examiner has offered no evidence or reasoned argument to the contrary.

With respect to claims 7, 9, 21, 23, 27 and 29 which specifically recite a ratio when the quencher is phosphorous acid, the Examiner stated that "Applicants failed to show that the ratio of 1 to 15 would yield UL rating of V0." The Examiner then cites a passage, with underlining, from ¶ 30, but provides no explanation of this passage or the highlighted part is relevant to the enablement rejection.

Claims 6, 8, 12, 14, 20, 22, 26 and 28 state that the acidic quencher is tosylate and is present in an amount of 1 to 10 ppm. This corresponds to the effective amounts in Table 1. The Examiner for some reason is discussing the text in Paragraph 28, relating to the molar ratio that these amounts correspond to. No explanation is provided, however as to how this is relevant to the enablement of these claims. Furthermore, the term "about 2" which the Examiner asserts is relevant even though it does not appear in these claims and is an approximation of 2.4 (the mole percent in table 1), as distinct from 1.2 (the next lower mole % in table 1). This does not support any lack of enablement for these claims.

Anticipation Rejection Over Rosenquist

In response to Applicants' arguments concerning the significance of the product by process language, the Examiner now asserts on Page 9 of the Examiner's Answer that "the claims do not require the presence of residual components" from base catalysis, and that "the polycarbonate could have been purified." The Examiner makes no showing that such a purification step would have been done, or that this new argument would be one that any person skilled in the art would consider reasonable. Furthermore, since the acid quencher is added to quench residual base (¶ 9), the Examiner's argument is an absurd construction that would not be reached by a person skilled in the art.

Applicants wish to correct a typographical error with respect to the argument on Page 6 of the Appeal Brief. The actual haze stated in Table 2B, Col. 3 is 1.3 % (not 1.4% as incorrectly

stated in the Appeal Brief) This number is still greater than 1%, however, such that these examples are plainly outside the scope of the present claims. The Examiner did not address this difference, and thus has not supported the anticipation rejection.¹

The Examiner also argues that the performance of a 1.6 mm film cannot be predicted without experimentation from the teaching that a 1.5 mm film is marginal. This is directly contradictory to the Examiner's previously made argument that a teaching of V0 at 75 mil inherently teaches a V0 rating at 1.6 mil. The reason for the argument as well as the reason for maintaining the rejection that depended on a now admittedly erroneous argument of inherency is not understood.

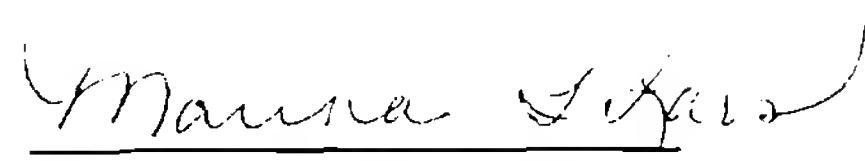
Obviousness Rejections

With respect to the rejection over the combination of Rosenquist and Sakashita, the Examiner argues on Page 10, that Rosenquist shows low haze levels. However, low haze levels within the scope of the claims are not shown in the Rosenquist compositions closest in composition to the claimed invention.

¹ It is noted that the Examiner did look at the Tables since he could point out the error (Examiner's Answer, page 9), but apparently had no argument to reply to the merits of this Applicants' position.

For the reason set forth above as well as those set forth in the Brief for Appellant, the rejections in this case should be reversed.

Respectfully submitted,



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